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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,231	10/30/2003	Sandra Helton McCain	2003-0309.01	9151
21972	7590	04/18/2005	EXAMINER	
LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			SHAH, MANISH S	
			ART UNIT	PAPER NUMBER
			2853	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,231

Applicant(s)	
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MCCAIN ET AL.

Examiner

Manish S. Shah

Art Unit	
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2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gundlach (# US 5560766).

Gundlach discloses an aqueous ink including an coloring matter a mixture of 0.1 to 3.5 wt.% of Acid Yellow 17 and 0.1 to 4 wt.% of Direct Yellow 132 (column: 3, line: 32-35); a humectant (column: 3, line: 53-60), a penetrant (surfactant) (column: 4, line: 44-50; column: 5, line: 30-40) and water (column: 3, line: 45-51).

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gundlach et al. (# US 5776230).

Gundlach discloses an aqueous ink including an coloring matter a mixture of 0.5 to 8 wt.% of Acid Yellow 17 and 0.5 to 8 wt.% of Direct Yellow 132 (column: 8, line: 35-60); a humectant (non-water component) (column: 7, line: 1-5), a penetrant (column: 7, line: 10-20) and water (column: 6, line: 51-55).

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gundlach et al. (# US 5788750).

Gundlach discloses an aqueous ink including an coloring matter a mixture of 0.5 to 15 wt.% of Acid Yellow 17 (column: 6, line: 60-65) and 0.5 to 15 wt.% of Direct Yellow 132 (column: 7, line: 1-5, 55-62) in acid form (column: 10, line: 1-20); a humectant (column: 6, line: 35-40), a penetrant (surfactant) (column: 11, line: 50-65 and water (column: 6, line: 19-24).

Response to Arguments

Applicant's arguments filed 03/07/2005 have been fully considered but they are not persuasive. Applicant argued that the prior art does not constitute an anticipation of all combinations with the range, which is not persuasive. All the three references are provided the ranges, which cover the applicant's claimed ranges. So It would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate about 4% of Direct Yellow 132 and from 0.5 to 1% of Acid Yellow 17, since it has been held that it is not inventive to discovering and optimum value or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233 (CCPA1955). Now it is burden on applicant to provide some kind of comparison study to show why there ranges are critical. However, on page 4 in Applicant specification, it disclose that ink having 4% of Direct Yellow 132 (about 3.72), and 1% of Acid Yellow 17, which covers by all three references.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2853

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MSS 4/5/05

Manish S. Shah
Primary Examiner
Art Unit 2853